DOCKET NO. 212969US6

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF   :

KEIGO IHARA, ET AL.   : EXAMINER: JOSHUA JOO

SERIAL NO: 09/932,968   :

FILED: AUGUST 21, 2001   : GROUP ART UNIT: 2154

FOR: SERVER RESERVATION   :
METHOD, RESERVATION CONTROL
APPARATUS AND PROGRAM STORAGE
MEDIUM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

SIR:

Applicants respectfully request that a pre-appeal brief conference be initiated in

accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

Failure to Present a *Prima Facie* Case of Obviousness

Applicants submit that the Official Action of May 3, 2005 fails to provide a *prima*

facie case of obviousness under 35 U.S.C. §103(a) with respect to Claims 1-8.

Claims 1, 3, 4, 6 and 8 were rejected as being unpatentable over Kusaba et al. (U.S.

Patent No. 6,510,556) in view of Cao (U.S. Patent No. 6,782,550); and Claims 2, 5 and 7

were rejected as being unpatentable over Kusaba et al. and Cao in view of Trewitt et al. (U.S.

Patent No. 6,134,531). As described in the Request for Reconsideration filed August 3, 2005,

this rejection is deficient in that all of the elements in the claimed invention are not found in

the asserted prior art. In particular, the Office has not met its burden of showing that the prior

art describes a reservation control apparatus that communicates with the processing server by way of a network.

Claim 1, for example, is directed to a method that enables a user of a user terminal apparatus to make a reservation request for a processing server via a reservation control apparatus. Thus, the method employed by Claim 1 uses three apparatuses: a user terminal apparatus, a reservation control apparatus, and a processing server. The reservation control apparatus controls a reservation state of the processing server <u>via a network</u>. This allows the user terminal apparatus to use functions of the processing server by accessing the processing server <u>via the network</u>. The method also includes a step of sending reservation request information from the user terminal apparatus to the reservation control apparatus <u>via the network</u>. Thus, the user terminal apparatus communicates with the reservation control apparatus <u>via the network</u>.

An advantage of the method of Claim 1, is that by having the reservation control apparatus control the state of the processing server via a network, the processing server can handle requests from a number of different reservation control apparatuses. Moreover, there need not be a unique relation between the reservation control apparatus and the processing server, as would be the case for the hypothetical method asserted in the outstanding Office Action.

To make a *prima facie* case of obviousness, the PTO has the burden of showing that all the elements of the claimed invention are found in the asserted prior art. This burden has not been met, as there has been no showing in the prior art of the use of a reservation control apparatus that communicates with the processing server by way of a network. In contrast, <u>Kusaba</u> uses a scheduler 105 that is dedicated for the purpose of operating with a video distribution apparatus as part of the transmitting station 11. Accordingly, Applicants

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respectfully request reversal of rejection of Claim 1 as well as Claims 3 and 4 which depend therefrom.

On the last page of the Advisory Action, the Examiner explains the reasons why the Examiner maintains the rejection of the claims. In particular, the Examiner argues that the claims do not require that the reservation control apparatus and the processing server be separate devices. The Examiner explains that he may ignore the language regarding the interconnection between the processing server and reservation control apparatus on two grounds: (1) the network is included in the preamble of the claim and so he does not need to consider it, and (2) the network "can be within a computer or an apparatus, thus a single entity".

Moreover, the Advisory states that only the preamble of Claim 1 explains that the reservation control apparatus is connected to the "processing" ["sic"] by a network. Because this structure is described in the preamble, the Examiner explains in the Advisory Action that "there is no clear indication or suggestion that the reservation control apparatus and processing server are separate as argued by the applicant". Applicants traverse this assertion. There is a clear indication of the structure that performs the method: the preamble clearly explains that the reservation control apparatus controls the processing state of the processing server via a network. The Examiner's reason is that a preamble is generally not accorded any patentable weight, citing in re: Hirao (see e.g. second to last paragraph of the Advisory Action). However, the claim is not explaining an intended use of a structure, but rather defining the structure itself. Furthermore, the body of the claim does depend on the preamble for completeness, because twice in the preamble the network is referred to (sending step and transmitting step). Furthermore, the claim describes a "processing server", not merely some apparatus or module that is a part of a reservation control apparatus. Accordingly, Applicants

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traverse the basis by which the language in the preamble, as well as the associated language (use of the term "network", and "server") in the body of the claim are being discarded.

The Advisory Action indicates that even if the preamble is taken into consideration, "controlling a reservation state of a processing server via network" does not indicate that the reservation control apparatus and processing server are separate. However, the Examiner's claim construction is repugnant to the ordinary meaning of the term "server" and "network". Kusaba discloses a scheduler 105 and video server 101 that are part of a single transmitting station 11. This structure in Kusaba cannot be asserted for a fair teaching of a reservation control apparatus that controls a reservation state of a processing server via network, because the alleged reservation control apparatus and processing server are both part of one apparatus (see video distribution operates 111 of Fig. 2), not separate as would be the case with devices that communication via a network. It is respectfully submitted that the asserted references are equally deficient with regard to Claims 3 and 4.

Claims 2 and 5, which also depend from Claim 1, are believed to be patentable over Kusaba and Cao in view Trewitt, as Trewitt is neither asserted, nor discloses the structure as claimed in Claim 1, which are absent in Kusaba. Therefore, it is believed that the rejection of Claims 2 and 5 is also deficient and therefore the undersigned requests that the rejection be withdrawn.

Claim 6 is directed to a reservation control apparatus and specifically includes a "means for determining whether or not the reservation request for the use of the processing server...will be accepted". This claim element is governed by 35 U.S.C. §112, sixth paragraph, and therefore part of the claimed "means" is the network. Accordingly, it is respectfully submitted that the outstanding Office Action is deficient with regard to its rejection of Claims 6 and 7 (where Claim 7 depends from Claim 6) for the reasons discussed

above with regard to Claim 1 and <u>Kusaba</u>. <u>Kusaba</u> does not disclose a processing server and

reservation control apparatus interconnected by a network. Accordingly, it is respectfully

submitted that Claim 6, 7 and 8 patentably define over any combination of <u>Kusaba</u>, in view of

<u>Cao</u> and <u>Trewitt</u>.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more

than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully submitted,

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